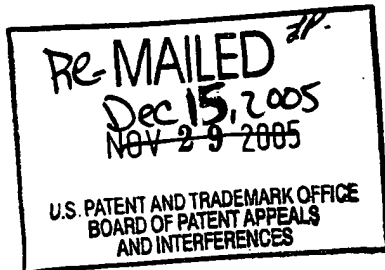


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte ULRICH REINERS, MICHEL PITTET

Appeal No. 2005-2344
Application No. 09/763,679

HEARD: October 20, 2005

Before OWENS, JEFFREY T. SMITH, and PAWLIKOWSKI, Administrative Patent Judges.

JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 17 and 19 to 21, all of the pending claims. We have jurisdiction under 35 U.S.C. § 134.

BACKGROUND

Appellants' invention relates to packaging material comprising a polypropylene foam base layer (A), together with further layers, one of which is a layer (B) adjacent to the base layer. The layer (B) comprises at least one of the polyolefins of the base layer (A). The total thickness of the layers (A) and (B) is 0.5 to 2 mm, and the thickness of layer B is from 1/6 to 1/2 the thickness of layer (A). (Brief, pp. 3). Representative claim 1 is reproduced below:

1. A multilayer film comprising the following sequence of layers:
 - A) a base layer of foamed propylene homopolymers, copolymer or mixtures thereof.
 - B) a layer comprising at least one of the polyolefins of the foam layer A,
 - C) optionally a tie layer based on a polyolefin
 - D) optionally an adhesive layer
 - E) optionally a gas barrier layer, a flavortight barrier layer, or both,
 - F) an adhesive layer,
 - G) an optionally sealable or peelable surface layer,whereby the total thickness of layers A and B ranges from 0.5 to 2 mm and the thickness of layer B ranges from 1/6 to 1/2 of the thickness of layer A.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following reference:

Laurent et al. (Laurent)

6,132,539

Oct. 17, 2000

The Examiner rejected claims 1-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurent. (Answer, pp. 3-4).

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review has led us to conclude that the Examiner's rejection under 35 U.S.C. § 103(a) is not well founded.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to Appellants' corrected Brief filed July 07, 2005, and the Examiner's Answer mailed March 15, 2004.¹

OPINION

The initial burden of presenting evidence to support a *prima facie* case of obviousness rests with the Examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In appropriate circumstances, a single prior art reference can render a claim obvious. See, e.g., *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). However, there must be a showing of a suggestion or motivation to modify the teachings of that

¹ The Examiner in the Answer mailed March 15, 2004, indicated that Appellants' Brief filed December 02, 2003 did not include appealed claims 19-21. The Examiner indicated in the communication mailed July 18, 2005, that the corrected Brief filed July 07, 2005 included the appealed claims 19-21. The Examiner did not write a supplemental Answer in response to the corrected Brief.

reference to the claimed invention in order to support a conclusion of obviousness.

This suggestion or motivation may be derived from the prior art reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

The independent claim 1 requires at least a base layer (A) comprising foamed propylene homopolymers, copolymer or mixtures thereof and a layer (B) comprising at least one of the polyolefins of the foam layer (A). The claim also specifies that the total thickness of layers (A) and (B) ranges from 0.5 to 2 mm and the thickness of layer (B) ranges from 1/6 to 1/2 of the thickness of layer (A).

The Examiner asserts that Laurent's invention is directed to a laminate comprising a first polyolefin foam layer which is laminated to a sealing film. The laminate comprises a polyolefin foam layer and a second binding layer located between the sealing film layer and the foam layer. The second layer and the first layer comprise polyolefins each based on the same monomer as the main monomer of the foam layer. (Answer, p. 3). Laurent discloses that the thickness of the foam layer is 0.5-2 mm and the thickness of the bonding layer is 5 to 30 μm . (Col. 3, ll. 33-45). According to the Examiner, Laurent also teaches that a foam layer is suitable for producing thermoformable laminate trays for food packaging. (Answer, p. 3). The Examiner recognizes that Laurent does not disclose the ratio for the layer specified by the

claimed invention. However the Examiner asserts "it is believed that adjusting the thickness of the bonding layer (and consequently the thickness ratio between the foam layer and bonding layer) is well within the ordinary skill of the art, motivated by the desire to provide suitable mechanical properties, such as stiffness, to the thermoformed tray, as taught by Laurent." (Answer, p. 4).

Appellants argue

The Examiner's contention is totally unsubstantiated by any teaching or suggestion found in the prior art. Nowhere can there be found any teaching or suggestion that the substantial improvement in mechanical properties demonstrated by Appellants' examples could be achieved by maintaining the total thickness of layers A + B in the range of 0.5 to 2.0 mm and the thickness of layer B in the range of 1/6 to 1/2 of the thickness of layer A.

There is no evidence whatsoever presented that would show that any person skilled in the art would be motivated to "adjust" the thickness ratio of Laurent's foam layer (B) and binding layer (30) to obtain a total thickness of these two layers that was between 0.5 and 2 mm, and a thickness ratio of layer (30) to layer (B) of 1/6 - 1/2. (Brief page 4).

Appellants further argue that "[i]t should be noted that even when Laurent's bonding layer is at its maximum thickness (30 μ m) and his foamed layer is at its minimum thickness (0.5 mm) (see col. 3, lines 34-45) the ratio of the bonding layer thickness to the foamed layer thickness is far below Appellants' minimum of 1/6. More specifically, layer 30 has a thickness range of 5 to 30 μ m. Since one μ m = 10^{-3} mm, Laurent's layer 30 has a thickness range of .005 - .030 mm. . .[] At best, therefore,

Laurent's ratio of layer (30) to his layer (B), would be only $0.030/0.5$ which = $1/17$. This is not even close to Appellants' ratio of from $1/6$ - $1/2$." (Brief, pp. 5-6).

As such, we do not agree with the Examiner's obviousness position as outlined in the Answer. The Examiner's reference to column 1 of Laurent as describing the properties resulting from the thickness of the coating film does not provide motivation for increasing the thickness of Laurent's bonding layer. The speculative position asserted by the Examiner is merely an unsupported opinion of the Examiner and such is not enough to establish the obviousness of the claimed subject matter within the meaning of 35 U.S.C. § 103. Rather, as our reviewing court has made clear, the Examiner must identify a particular suggestion, reason or motivation to combine references or make the proposed modification in a manner so as to arrive at the claimed invention. See *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). Any such showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In the present case, sufficient evidence to establish such a suggestion is not made manifest in the Examiner's stated rejection based on the teachings of the applied references. We conclude that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the subject matter of appealed claims 1-17 and 19-21.

Rejections based on § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the Appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

From our perspective, the Examiner's rejection appears to be premised on impermissible hindsight reasoning. On the record of this appeal, it is our view that the Examiner has not carried the burden of establishing a *prima facie* case of obviousness with respect to the subject matter defined by the appealed claims.

Since we reverse for the lack of the presentation of a *prima facie* case of obviousness by the Examiner, we need not reach the issue of the sufficiency of the evidence as allegedly demonstrating unexpected results. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

REVERSED

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